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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,987	06/29/2000	Moshe Koppel	197/01184	7822

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EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/605,987

Applicant(s)

KOPPEL ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38,40-44,46,47 and 57-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-38,40-44,46,47,57 and 58 is/are allowed.
- 6) ☒ Claim(s) 59-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/10/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Application History***

1. This action is responsive to the Request for Continued Examination, filed on 3/7/2005.
2. In the office action dated 12/7/2004, claims 1-38, 40-44, 46, 47, 57 and 58 were allowed.
3. Applicant has added claims 59-62.
4. Claims 1-38, 40-44, 46, 47 and 57-62 are pending in the case, claims 1, 8, 9, 24, 46, 59, 60 and 61 are independent claims.
5. Acknowledgement is made to the applicant's submission of an Information Disclosure Statement, filed 3/10/2005.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

*"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."*

7. Claims 59-62 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. **Regarding Claims 59-62**, the claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. Claims 59-62 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes"*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."*

10. Claims 59-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
11. **Regarding claim 59**, the amendment filed 3/7/2005 adds the following limitations: *"generating documents based on a search query"* (preamble), *"obtaining an initial set of documents relevant to the search query"* (first limitation), *"assigning relevance scores to the documents based on cross references between the documents within the initial set"* (second limitation), and *"sorting the documents based on the assigned relevance scores"* (third limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

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12. **Regarding claim 60**, the amendment filed 3/7/2005 adds the following limitations: *"responding to a search query from a user"* (preamble), *"receiving the search query from the user"* (first limitation), *"generating a list of relevant documents based on search terms of the query"* (second limitation), *"generating relevance scores for the documents in the list of relevant documents based on cross references between the documents in the list"* (third limitation) and *"returning a set of relevant documents to the user, the set being sorted based on the relevance scores"* (fourth limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
13. **Regarding claim 61**, the amendment filed 3/7/2005 adds the following limitations: *"providing search results"* (preamble), *"providing a search term"* (first limitation), *"generating a limited list of results indexed to said search term"* (second limitation), *"generating a limited set of pages including links to said limited list and indexed to said search term"* (third limitation) and *"generating a set of search results responsive to the number of links from said limited set to pages in said limited list."* (fourth limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

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14. **Regarding claim 62**, the amendment filed 3/7/2005 adds the following limitation: "*generating a limited set of pages comprises selecting pages including said search term*". The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."*

16. Claims 59-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan et al., US Patent 6,421,675 (filed 7/15/1998, patented 7/16/2002). "Ryan et al." is hereafter referred to as "Ryan".

17. In regard to independent claim 59, Ryan discloses generating documents based on a search query. Ryan recites: *"The present invention relates to a method and apparatus that allows for enhanced database searching, and more particularly; for use as an internet search engine"* (column 1, lines 8-10) and *"The results of this search are then displayed to the user, as shown by steps of displaying a created list of web pages"* (column 4, lines 36-38). Ryan discloses obtaining an initial set of documents relevant to the search query. Ryan recites: *"the URL address of the web page or pages that they wish to submit"* (column 5, lines 36-37). Ryan discloses assigning relevance scores to the documents based on the cross references between the documents within the initial set and sorting the documents based



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on the relevance scores. Ryan recites: *"Hit-list: The list of web-pages URL addresses that is the result of the key-word search. This hit-list ranks the relevance of the web-pages"* (column 6, lines 12-14).

18. **In regard to independent claim 60**, Ryan discloses responding to a search query, obtaining an initial set of documents relevant to the search query and assigning relevance scores to the documents based on the cross references between the documents within the initial set and sorting the documents based on the relevance scores as described in the previous paragraph. Ryan further discloses receiving a search query from a user. Ryan recites: *"The search engine receives the search command, and then using it scans for these key words through a database of web addresses and the text stored on the web sites"* (column 1, lines 25-28).

19. **In regard to independent claim 61**, Ryan discloses providing search results in response to a provided search term, and generating a limited list of results indexed to the search term as described in the previous paragraphs. Ryan discloses generating a limited set of pages including links to the limited list and indexed to the search term. And generating a set of search results responsive to the number of links from the limited set of pages in the limited list. Ryan recites: *"In an attempt to index the information available on the internet, a number of software search engines have been created via which a user enters a search command"* (column 1, lines 19-22) and *"The search*

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*engine receives the search command, and then using it scans for these key words through a database of web addresses and the text stored on the web sites" (column 1, lines 25-28).*

20. In regard to dependent claim 62, Ryan discloses selecting pages including the search term. Ryan recites: *"The user typically makes a selection from the list"* (column 1, line 56).

#### ***Allowable Subject Matter***

21. Claims 1-38, 40-44, 46, 47, 57 and 58 are allowed, as described in the *Reasons For Allowance* section of the office action dated 12/7/2004.

#### ***Response to Arguments***

22. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

**Conclusion**

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Vaughn  
May 24, 2005

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**